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OFFICE OF PETITIONS

Paper No. 16

In re Patent 5,745,906
Issued: April 28, 1998
Application No. 08/557,586
Filed: November 14, 1995
Attorney Docket No. 24901-0044

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.182, filed July 15, 2010, to expunge an assignment previously recorded against the above-identified application.

The petition is **DISMISSED**. This is not a final agency action.

Petitioner asserts that the assignment recorded in the Patent Office on May 10, 1996, at Reel/Frame 007933/0196 (Assignment #1) contains an error in the receiving party listed therein. In requesting to expunge this recorded assignment, petitioner states, “[t]he Assignment #1 itself identifies DeltaTech Research, Inc. as the assignee, but the Recordation Cover Sheet erroneously noted Hewlett-Packard Company as the receiving party. The subsequent Assignment, recorded at Reel/Frame 008132/0725 (“Assignment #2), sought to correct this error (see Reel/Frame 008132/0726), but the Recordation Cover Sheet failed to note the “Nature of Conveyance” as a “Corrective Document” (instead identifying it as an “Assignment”).” Expunging information from USPTO assignment records requires an extraordinary remedy that is properly addressed under 37 CFR 1.182.

The USPTO will not normally resort to an extraordinary remedy under 37 CFR 1.182 if the rules of practice and the procedures before the USPTO already provide an avenue for the requested relief. See Cantello v. Rasmussen, 220 USPQ 664, (Comm'r Pats. 1982). Petitioner should note that, as discussed in section 323.01(d) of the Manual of Patent Examining Procedure (MPEP), petitions to correct, modify or “expunge” assignment records are granted only if the petitioner can prove that:

- (A) the normal corrective procedures outlined in MPEP § 323.01(a) through §323.01(c) will not provide the petitioner with adequate relief; and
- (B) the integrity of the assignment records will not be affected by granting the petition.

The instant petition fails to prove items (A) and (B), listed above. Petitioner is encouraged to consider the corrective procedure outlined in MPEP §323.01(a), instead of filing a renewed petition.

As background, the USPTO simply acts in a ministerial capacity in recording documents that have been submitted for recordation. See 35 USC 261 and 37 CFR 3.11. The recording of a document pursuant to 37 CFR 3.11 is **not** a determination by the USPTO of the validity of the document *per se* or the effect that document has on the title to a patent or application. See 37 CFR 3.54. Such a determination must be made by a competent authority, like a court of appropriate jurisdiction. Moreover, it is USPTO policy to maintain a complete history of claimed interests in a given property, and, as such, a recorded assignment document will be retained, even if it is subsequently found to be invalid. In re Raney, 24 USPQ2d 1713 (Comm'r Pat. 1992). Accordingly, information will not be expunged from assignment records merely to present correct information in the records.

The required fee of \$400.00 under 37 CFR 1.182 has been charged to Deposit Account 50-1349, as authorized.

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

Telephone inquiries concerning this communication should be directed to Ramesh Krishnamurthy at (571) 272-4914.



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